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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/058,122	01/29/2002	Philip B. Sample	00167-455001	3500

7590

10/04/2006

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EXAMINER

SHAFFER, RICHARD R

ART UNIT

PAPER NUMBER

3733

DATE MAILED: 10/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/058,122

Applicant(s)

SAMPLE, PHILIP B.

Examiner

Richard R. Shaffer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-75 is/are pending in the application.
- 4a) Of the above claim(s) 4,7-10,20,22,31,32,34-36 and 38 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,5,6,11-19,21,23-30,33,37 and 39-75 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Allowable Subject Matter

The indicated allowability of claims 24-30 and 33 is withdrawn due to further consideration of the previously applied reference to Staehlin et al (US Patent 6,309,394). Rejections based on the interpretation follow.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 5, 6, 11-19, 21, 23-30, 33, 37 and 39-75 are rejected under 35 U.S.C. 102(b) as being anticipated by Staehlin et al (US Patent 6,309,394).

Staehlin et al disclose a device (**Figure 11**) comprising: an outer member (518 and 534 together) with a spherical (**See Figure 15A**) terminal end at its distal end; the terminal end defines an opening (**See Figure 15A**) which includes a cutting portion; a hollow (Definition of hollow from Dictionary.com Unabridged V 1.0.1 is given as: *having a depression or concavity; a hollow surface.*) inner member (**560** with the depression being just under the section **564**) received within the outer member; a cutter (**514, 516, and 532 together**) coupled to the inner and outer members such that rotation of the inner member about an axis causes off-axis/perpendicular movement of the cutter (**Column 11, Lines 36-49**); the outer member has first and second arch-shaped chambers (**530 on both 518 and 534**); the chambers are located in an inner surface

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(See Figure 11) of the terminal end of the outer member (518 and 534); the cutter has a first (548a) and second shaft (548b) located 180 degrees apart from each other along an outer surface of the cutter; each shaft is in a respective one of the outer member chambers (530); the shafts (548a/b) have teeth that directly interact with teeth (on gear 550) located on the distal end of the inner member; the cutter comprises a hollow body (Figures 13A-13D) with a cutting portion (opening for 514) and an extended portion (520).

The method steps recited in claims 27-30 and 33 are covered by the device disclosed in Figure 11 in normal use when the cutter sweeps into a parallel orientation with the outer member thereby extending the cutter distally of the distal end of the outer member. As for cutting tissue, it is noted that bone is tissue. The cutting action would be slicing, and it has already been stated that rotating the inner member causes an off-axis/perpendicular rotation of the cutter.

In regard to apparatus claims claiming configured to shear tissue between the cutter and outer member, the device is inherently capable of holding tissue between the cutter assembly and the outer member to cause a shearing of the tissue.

In regard to product-by-process recitations of the terminal end opening of the outer member is formed by a cut and the cutter opening is molded, they are given no patentable weight. Patentability depends on whether a **product** is known in the art or it is obvious, and is not governed by whether the process by which it is made is patentable. *In re Klug*, 333 F2d 905, 142 USPQ 161 (CCPA 1964).

Response to Arguments

Applicant's arguments filed July 14th, 2006 have been fully considered but they are not persuasive. Applicant alleged that the addition of "hollow" was not anticipated by Staehlin et al. As described in the current Office Action, hollow can merely refer to having a depression along its surface. In regard to claim 47, it is not found persuasive because if the cutter was already active but not engaged with tissue, motion by the inner member would be required to "cut tissue."

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Richard R. Shaffer whose telephone number is 571-272-8683. The examiner can normally be reached on Monday-Friday (7am-5pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Richard Shaffer
September 28th, 2006



EDUARDO C. ROBERT
SUPERVISORY PATENT EXAMINER